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PATENT APPLICATION

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor: Berkema et al.

Confirmation No.: 9773

Application No.: 09/897,653

Examiner: Wallerson, Mark E

Filing Date: 06/29/2001

Group Art Unit: 2626

Title: PRINT BY REFERENCE METHOD FOR PORTABLE WIRELESS DEVICES

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __March 28, 2006__ .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)
for the total number of months checked below:

( ) one month $120.00
( ) two months $450.00
( ) three months $1020.00
( ) four months $1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of ___$500.00___ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Rev 12/04 (Aplbrief)

Respectfully submitted,

Berkema et al.

By

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Date: **May 30, 2006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Berkema et al.
Serial No.:	09/897,653
Conf. No.:	9773
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For:	PRINT BY REFERENCE METHOD FOR PORTABLE WIRELESS DEVICES
Art Unit:	2626
Examiner:	Mark E. Wallerson

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

May 30, 2006

Date   *Registration No.* 35,132
F-CLASS.WCM
Appr. February 20, 1998 *Attorney for Applicant(s)*

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL PURSUANT TO RULE 192

REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the state of Texas, having a principal place of business at 20555 S. H. 249 Houston, TX 77070, USA (hereinafter "HPDC"). HPDC is a Texas limited partnership, and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed January 23, 2006 for U.S. Patent Application Serial No. 09/897,693, and an appeal brief was filed March 23, 2006. A Notice of Appeal was also filed February 13, 2006 for U.S. Patent Application Serial No. 09/897,656, and an appeal brief was filed April 11, 2006. Another Notice of Appeal was filed February 6, 2006 for U.S. Patent Application Serial No. 09/897,647, and an appeal brief was filed April 6, 2006. These applications are not technically related, but disclose related subject matter.

STATUS OF CLAIMS

Claims pending, finally rejected, and appealed 2-4, 6, 15, 17, 18, 21-24, 30, 32, and 33.

STATUS OF AMENDMENTS

No amendments were filed after the Final Office Action mailed December 28, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 2, 3, 4, 6, 15, 17, 21, and 30 define a print by reference method 24 (FIG. 3) executable by a portable wireless device 10. FIGs. 1-2; P5, L8-9, L 24-28. The method includes the step of obtaining a reference to print content 26. FIG. 3; P7, L 6-10. The print content is stored at a location indicated by the reference. P7, L9-10. For example, a portable wireless device 10 may obtain the reference in response to a user command entered by the user while surfing the internet via an internet interface 12. P7, L 10-12.

Claims 2, 3, 4, 6, 15, 17, 21, and 30 further define wirelessly communicating the reference to another device, such as a print device 22 or a print service 16, to initiate a print by reference of the print content P7, L30 - P8, L2. This wireless communication initiates print by reference of the print content. P10, L1-9. For example,

wirelessly communicating the reference may cause a print device 22 to use the reference to download print content associated with the reference from an internet content provider (P10, L1-3), or to respond to the reference by providing the reference to a network/internet based print service 16. P10, L5-7. In other words, it is the wireless communicating of the reference that causes (i.e., initiates) the print by reference. P3, L23-26.

Claim 2 further defines that the reference specifies billing information. This reference, which is the reference wirelessly communicated from the portable wireless device to another device to initiate the print by reference operation, may specify billing information, for example, by formatting the reference according to a richer data format having a set of extensions or attribute fields. P8, L12-14; P9, L4-5.

Independent claim 3 further defines that the reference specifies print format information. As an example, the reference may specify when print content should be printed beginning on a new sheet. P8, L23-24. As another example, print format information may include a location of a remote print service 16 that may be used in accessing and formatting print content for printing. P8, L15-17. This information is included with the reference. P8, L7-14.

Independent claim 4 further defines that the reference specifies time and date information. This information may include, for example, the time and date that the reference was sent to a print device 22. P8, L17-18. According to independent claim 6, the reference specifies a number of copies of the print content to be printed by a print device.

According to independent claim 15, the print by reference method further comprises communicating a discovery signal 36. FIG. 4. The discovery signal comprises a request for information (P11, L20-26) regarding a capability of another device. P12, L14-15. For example, the information may specify whether a print device 22 has color printing capabilities, whether the print device is equipped for printing specialized graphic files, and further specifying the costs associated with using the print device to print a document. P12, L14-19.

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Independent claim 17 further defines receiving a print status message from another device 32. FIG. 3; P10, L12-14. Independent claim 21 also defines that this device comprises a print service 16 (FIG. 1) adapted to use the reference to obtain the print content P10, L5-9; FIG. 6, step 56; P15, L1-3. According to independent claim 30, the reference further specifies a print format data specifying that the print content should be printed beginning on a new sheet of paper P8, L23-24.

Independent claim 32 defines a print by reference method 24, 52, 62 executable by a portable wireless device 10. The method comprises the step of obtaining a reference 26, 44 to print content stored at an internet location 14 indicated by the reference. Further, according to independent claim 32, the reference is included in a communication signal 28 (FIG. 3) or 46 (FIG. 5), which is formatted according to a Bluetooth communication protocol and wirelessly communicated 46 to a print device 22. P5, L28 - P6, L1; P6, L2-8; P9, L21-24.

Claim 33 defines a method 52, 66 executable by a portable wireless device 10. The method comprises the steps of obtaining a reference 54, 64 to print content stored at an internet location 14 indicated by the reference. P7, L8-10; P15, L3-7. The reference is included in a communication signal 56, 66 formatted according to a Bluetooth communication protocol. P15, L7; P9, L20-24; P5, L24 - P6, L8. The method further comprises wirelessly communicating 56, 66 the communication signal to a print service 16 thereby causing the print service (P15, L25-28) to use the reference to retrieve the print content from the internet (P15, L12-13; P16, L4-5), format the print content for printing (P15, L13-14), and pass 70 the print content to a print device 22 for printing. P15, L12-14.

ISSUES TO BE REVIEWED ON APPEAL

1) The rejection of claims 3, 6, 15, 17, 18, 21, 22, 23, 24, and 30 under 35 U.S.C. § 102(b) as being anticipated by Wolff '841.

2) The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Wolff '841 in view of Wolff '413.

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3) The rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Wolff '841 in view of Lamming.

4) The rejection of claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Wolff '841 in view of Nachtsheim.

ARGUMENT

I. The Rejection of Claims 3, 6, 15, 17, 18, 21, 22, 23, 24, and 30 Under 35 U.S.C. § 102(b) as Being Anticipated by Wolff '841.

A. The Rejection of Claims 3, 6, 15, 17, 21-24, and 30 Should be Reversed, as Wolff '841 Fails to Teach or Suggest at Least Wirelessly Communicating a Reference to Another Device to Initiate a Print By Reference Operation, Where the Reference Indicates the Location of Print Content.

Independent claims 3, 6, 15, 17 (with dependent claim 18), 21 (with dependent claims 22-24), and 30 define, among other things, "obtaining a reference to print content stored at a location indicated by the reference [and] wirelessly communicating the reference to another device to initiate a print by reference of the print content". This requires that a reference that initiates a print by reference operation when communicated to another device also indicates a location where print content is stored. As explained, for example, at P7, L8-10 of the present application, "the portable wireless device 10 obtains a reference that indicates the location of the desired print content". As further described at P10, L1-3, "after having received the reference, the print device 22 may respond by using the reference to download the print content associated with the reference".

Wolff '841 is directed to a system in which a browser client can work with a print server through a network by an exchange of web pages such as the pages shown in FIGs. 3A, 3B, and 4. C2, L65 – C3, L3. This is enabled with a print server that is "a

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printer agency that may be used to provide a document centric interface". C5, L50-51; C9, L5-6. In the operation of Wolff '841's invention, printing occurs only after an interface is established between a client 210 and a network server. C6, L1-53. The system of Wolff '841 avoids the necessity for a host computer (C2, L59-62), but requires a browser exchange to affect printing and requires that the client be attached to the network. C5, L33-49.

Wolff '841 discloses wireless communication between a client 210, such as a personal digital assistant (PDA) 930, and a print server 255. C8, L48-49. However, unlike the methods defined in claims 3, 6, 15, 17, 21, and 30, in Wolff '841's initial communication between a client 210 and a print server 255, the print server 255 and client 210 create an HTML session, wherein the client is permitted to select documents within the browser for printing. C5, L33-62. The initial communications in Wolff '841's system between a client 210 and a print server 255 are not to initiate a print by reference, but to establish a browser session with a client. C5, L33-36.

As provided, for example, in claims 11 and 23 of Wolff '841, in response to a request from a browser client, a printer retrieves documents to be printed from a server and transmits the retrieved documents to the browser client to be viewed prior to printing the documents. In Wolff '841, with the HTML session created, the print server 255 obtains the document from a server 220 or 230, and renders the document with control buttons to the client 210 via the HTML browser. C6, L1-20. The HTML session allows, for example, the client 210 to select particular documents, and render the obtained documents in a particular way, such as in a book format. C6, L54-61. FIG. 6 of Wolff '841 illustrates a book selection page displayed on a browser 320 for a client from which the client may select documents for printing. C7, L50-64. If the client 210 wishes to print the obtained document, a selection is made within the HTML document, at which time the document is transmitted for download to the printer 250. C6, L15-18.

Outside of a standard browser session, Wolff does not disclose any form of printing by reference. The Examiner states (December 28, 2005 Office Action, Page 7) that Wolff '841 teaches printing by reference by disclosing "that a URL (reference) is used by a user (column 6, lines 33-42) to print a document stored on a server (column 6,

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lines 33-63)." However, this "printing by reference" is part of a standard HTML browsing session between the client 210 and the print server 255 (C6, L1-32), and thus it still fails to teach or suggest the other features of the claims. In claims 3, 6, 15, 17, 21, and 30, the information included in the reference refers to the reference that is used to initiate a print by reference operation, and the reference includes the location of the print content reference for printing. There is no comparable communication from the client 210 in Wolff '841, which is conducting an HTML session initiated through a standardized HTML interface. C5, L33-62. Documents are selected for printing only within a browser interface. C6, L1-6.

B.   The Rejection of Claim 3 Should be Separately Reversed, as Wolff '841 Fails to Teach or Suggest That the Reference That Initiates a Print By Reference Operation Specify Print Format Operation.

Claim 3 further defines, among other things, that "the reference specifies print format information". As explained above, this is the reference that is wirelessly communicated to another device to initiate a print by reference of print content. In rejecting claim 3, the Examiner (December 28, 2005 Office Action, Page 3) points to C6, L7-20 of Wolff '841 as disclosing that the reference specifies print format information. This section of Wolff '841 is discussing a view page 350 that includes an "OPTIONS" button. The view page 350 is "displayed on a browser 320 residing in a client 210". C6, L12-13. This does not meet the claim language.

As stated above, claim 3 requires that the reference wirelessly communicated to another device to initiate a print by reference of the print content specify the print format information (and indicate the location of the print content). This requirement is neither met nor suggested by the view page 350 in FIG. 3A of Wolff '841. In response to a request for an HTML document to be printed on a printer 250, the view page 350 is returned to the client 210 by the print server 255 and includes an OPTION button. C6, L7-10; C6, L13-19. Even if selection of the OPTION button permits the communication of print format information, the use of the OPTION button is not a

reference that initiates a print by reference operation, as required by claim 3, nor is it a reference that also indicates a location of the print content (at least because the document has already been obtained – C6, L2-3).

C.   **The Examiner's Statement That Wolff '841 "Discloses That the User Specifies the Format in Which the Document is to be Printed" Ignores the Claim Requirement That the Print Format be Submitted With the Reference That Initiates the Print By Reference Operation.**

The Examiner (December 28, 2005 Office Action, Page 7) argues that the reference "discloses that the user specifies the format in which the document is printed (column 6, lines 54-63)." This section refers to rendering compound documents in a book format (see, e.g., FIGs. 4-6). Again, however, there is no teaching in Wolff '841 that such user specifying is part of a wirelessly communicated reference that initiates a print by reference operation, nor that it is part of a reference that also indicates a location of print content.

D.   **The Rejection of Claim 6 Should be Separately Reversed, as Wolff '841 Fails to Teach or Suggest That the Reference That Initiates a Print By Reference Operation Specifies a Number of Copies of the Print Content to be Printed by a Print Device.**

Claim 6 further defines, among other things, that "the reference specifies a number of copies of the print content to be printed by a print device." Again, the reference referred to is the same reference that is wirelessly communicated to another device to initiate a print by reference operation, and is the same reference that indicates a location of print content.

The Examiner (December 28, 2005 Office Action, Page 3, Page 7) cites C4, L65 – C5, L3 of Wolff '841 as disclosing the feature wherein "the reference specifies a number of copies of the print content to be printed by a print device". There is no such

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disclosure in the cited portion of Wolff '841. C5, L1 refers to "a compound document". This compound document is said to be "linked documents that are located within a received document." C5, L2-3. The example provided in Wolff '841 is a book including one or more levels of linked documents (C6, L56-61).

Thus, contrary to the Examiner's assertion (December 28, 2005 Office Action, Page 7), "specifying a compound document" refers not to specifying a number of copies of print content, but to specifying what documents will make up a particular compound document. There is no discussion of specifying how many copies of the compound document to print, and there is no teaching of selecting how many copies of any particular document would go into the compound document. Simply teaching a "compound document" does not teach printing a number of copies of any particular document, whether it is a compound document or some other form of document.

Additionally, there is no teaching, or even alleged teaching in the Office Action, that a selection of printing a compound document is part of a reference that is wirelessly communicated to another device to initiate a print by reference operation, as required by claim 6. Selection of a compound document itself alone fails to teach or suggest that such selection is part of a reference that initiates a print by reference operation. Instead, the compound document cited in the Office Action is exemplified by a book, which is selected via a bookmaker page 400. C6, L54-61; C7, L9-64. As stated above, this bookmaker page 400, shown by example in FIG. 6, is part of a standard HTML session, in which a client simply selects documents within the browser for printing.

II. The Rejection of Claim 2 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Wolff '841 in View of Wolff '413.

A. The Rejection of Claim 2 Should be Reversed, as Wolff '841 Fails to Teach or Suggest at Least That a Reference That Initiates a Print by Reference Operation Also Indicates the Location of Print Content.

Claim 2 defines, among other things, "obtaining a reference to print content stored at a location indicated by the reference [and] wirelessly communicating the reference to another device to initiate a print by reference of the print content". As stated above with respect to claims 3, 6, 15, 17, 21, and 30, which remarks are incorporated by reference herein, this requires that the reference that initiates the print by reference of the print content includes a location of the print content. As also stated above, Wolff '841 fails to teach at least this feature, and thus Wolff '841 is not properly applied to claim 2.

B. Wolff '413 Does Not Disclose Communicating Billing Information, Let Alone Including Billing Information With a Reference That Initiates a Print By Reference Operation.

Claim 2 further defines, among other things, that "the reference specifies billing information". Wolff '841 also fails to teach this feature (which is recognized by the Examiner -- December 28, 2005 Office Action, Page 4). Wolff '841 initiates a browser session between a client 210 and a print server 255. C5, L33-62. The initial communications in Wolff '841 are to establish a browser session, and there is nothing corresponding to a reference that is used to initiate the print by reference of print content, wherein the reference both indicates the location at which the print content is stored and includes billing information.

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The Examiner (December 28, 2005 Office Action, Page 4) cites Wolff '413, C10, L31-36 to remedy the deficiencies of Wolff '841 regarding a reference including billing information. However, at best, Wolff '413 merely suggests paying for content as a general principle. C10, L31-36 teaches only that a gateway may be used by companies to provide "fax" customers with Web access, and that the gateway could add advertisements or charge for using the gateway service. Claim 2 is not directed to the general concept of paying for content, nor is it directed to the general concept of paying for content that is or may be printed. Instead, claim 2 clearly defines that the reference used to initiate a print by reference operation and that indicates the location of print content also includes billing information.

The cited portion of Wolff '413 does not include any discussion of billing information, let alone including billing information in a reference used to initiate a print by reference operation. It gives no suggestion to modify the teachings of Wolff '841 to teach the claimed invention, nor does it suggest how such a modification would be done. Wolff '413 is directed to a fax method for ordering documents. C1, L6-11; C1, L55-64. Wolff '841, on the other hand, is concerned with a browser method for ordering documents. C3, L1-3. Neither reference discloses a print by reference operation within the meaning of the reference that is defined in the claim.

III. The Rejection of Claim 4 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Wolff '841 in View of Lamming.

A. The Rejection of Claim 4 Should be Reversed, as Wolff '841 Fails to Teach or Suggest at Least That a Reference That Initiates a Print By Reference Operation Also Indicates the Location of Print Content.

Claim 4 defines, among other things, "obtaining a reference to print content stored at a location indicated by the reference [and] wirelessly communicating the reference to another device to initiate a print by reference of the print content". As stated

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above with respect to claims 3, 6, 15, 17, 21, and 30, which remarks are incorporated by reference herein, this requires that the reference that initiates the print by reference of the print content includes a location of the print content. As also stated above, Wolff '841 fails to teach at least this feature, and thus Wolff '841 is not properly applied to claim 4.

B.   Neither Wolff '841 nor Lamming Teaches or Suggests That a Reference Used to Initiate a Print By Reference Operation Includes Both a Location of Print Content and Time and Date Information, and Thus the Combination Fails to Teach Every Element of the Claim.

Claim 4 further defines, among other things, that "the reference specifies time and date information". This means that the reference that is used to initiate a print by reference operation and that identifies a location of print content also specified time and date information. This feature is missing from both Wolff '841 and from Lamming. As stated in MPEP 2143.03, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Because all claim features are not provided even by the combination of references, *prima facie* obviousness has not been established.

The Examiner recognizes that Wolff '841 fails to teach or suggest that a reference specifies time and date information (December 28, 2005 Office Action, Page 5), but teaches Lamming, abstract and C2, L52-56, for this feature. However, though time and date stamps are disclosed in Lamming, these concern the movements of people (see, e.g., Tables 1 and 2, abstract), not document ordering. Particularly, the time and date stamps in Lamming are for tracking the locations of users in kitchens, offices, and the like. C4, L48-64. There is no teaching of using time and date stamps in a reference to

initiate a print by reference operation, at least because Lamming is not concerned, in any way, with printing by reference.

Thus, even if the Examiner's alleged motivations for combining Wolff '841 and Lamming (December 28, 2005 Office Action, Page 5 and Page 7) were proper, at best an artisan would, as stated by the Examiner, "have modified Wolff '841 by the teaching of Lamming '665". This modification, even if suggested in the art, fails to provide the invention defined in claim 4.

C.   There is No Motivation to Combine Wolff '841 and Lamming, as Lamming is Concerned with Tracking Movements of Users, Not with Document Ordering, as Disclosed in Wolff '841.

As stated above, Lamming uses time and date stamps to track people. For example, when a user, namely a person, encounters another object, a time stamped record is created in a database concerning that user. C4, L48-64. The arrival of people to their own or other's offices is tracked in a database, as shown in Tables 1-2. Lamming is completely unconcerned with document ordering, which is the sole purpose of the web-based document of Wolff '841. Thus, there is no motivation to modify Wolff '841 to incorporate a time and date stamp in any event, let alone including time and date information to a reference that is wirelessly communicated to initiate a print by reference operation.

D.   The Examiner's Stated Motivations to Combine Wolff '841 and Lamming Have No Basis in the Lamming Reference.

The Examiner (December 28, 2005 Office Action, Page 5 and 7) alleges two motivations for combining Wolff '841 and Lamming (though even if combined, the references still fail to teach all of the features of claim 4). The first alleged motivation is to "more clearly specify the images to be retrieved." This has no basis in the Lamming reference, as Lamming is concerned with tracking the movements of users (C1, L7-11),

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not with specifying images to be retrieved or other document ordering issues. It is not clear at all how tracking a user's relationship to other objects in a database relates to "more clearly specify the images to be retrieved".

The second alleged motivation is that "the addition of time information with respect to the stored information allows for an increase in the speed of searching (the abstract of Lamming)". However, the "searching" in Lamming is merely for "information relevant to the activities of the user" (abstract), or for information stored generally in a backup memory (C1, L7-11). This general teaching would not alone provide a suggestion to an artisan to modify Wolff '841, let alone to modify Wolff '841 to provide the invention of claim 4.

IV. The Rejection of Claims 32 and 33 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Wolff '841 in View of Nachtsheim.

A. The Combination of Wolff '841 and Nachtsheim is Inappropriate to Reject Claims 32 and 33, as Nachtsheim is Specifically Directed to a Completely Different Art - Interference with Airline Navigational Equipment.

Claims 32 and 33 define, among other things, "obtaining a reference to print content stored at an Internet location indicated by the reference" and "including the reference in a communication signal formatted according to a Bluetooth communication protocol". The communication signal is wirelessly communicated to a print device (claim 32) or to a print service (claim 33). The Examiner recognizes (December 28, 2005 Office Action, Page 6) that Wolff '841 fails to teach or suggest communicating the reference in Bluetooth format. Nachtsheim is cited for this feature.

However, there is no motivation to modify Wolff '841 based on Nachtsheim, as Nachtsheim is directed to a completely different and very peculiar application – namely, the detection of active devices that may interfere with airline navigational equipment during takeoff or landing. C1, L5-13. According to Nachtsheim, a central radio 100 detects active devices, permitting airplane cockpit crew or flight

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attendants to monitor to ensure that devices are turned off. C2, L5-16. The system of Nachtsheim has nothing whatsoever to do with the browser interface for ordering documents that is disclosed in Wolff '841. Wolff '841 is not concerned at all with detecting the client 210, let alone with interference of wireless devices in an airplane.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Nachtsheim clearly is not within the field of Applicants' endeavor. Further, Nachtsheim is not reasonably pertinent to the particular problem of wirelessly communicating a reference to print content to a print device or a print service.

Nachtsheim is fully and solely concerned with detecting devices so that they may be properly shut down. C1, L5-14. Commands are communicated to the devices telling them to shut down. C2, L39-57. If the references were combined, it might suggest that the client 210, if it were a PDA, could be detected by an airline crew, but it suggests no other modification to Wolff '841. An artisan would not seek to use the wireless detection method of Nachtsheim to modify the print operations in Wolff '841.

B.   The Examiner's Stated Motivations to Combine Wolff '841 and Nachtsheim to Reject Claims 32 and 33 Are Too General to Import Any Particular Teaching to an Artisan.

Again, these are two completely unrelated references. It appears that Nachtsheim has been selected based upon the sole fact that it uses Bluetooth. However, the Examiner (December 28, 2005 Office Action, Page 6 and Page 7) alleges two motivations for combining Wolff '841 and Nachtsheim. The first motivation is "to improve the communication process". It is not clear how Nachtsheim improves the "communication process". Further, this motivation is generic and cannot be used to support a combination of any two particular references. "To improve the communication process" is a platitude that could be applied to any system involving communications.

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The Examiner's second stated motivation, "This standard is used to improve the point-to-point and point-to-multipoint communications (column 1, lines 15-25)", is only slightly less generic than the first motivation. Further, it still provides no suggestion for looking to Nachtsheim to modify Wolff '841 in any event, let alone for modifying Wolff '841 to include a reference to print content in a communication signal that is formatted according to a Bluetooth communication protocol. This specific claim feature would not be apparent merely by a teaching that Bluetooth is used to improve point-to-point and point-to-multipoint communications.

C.   **The Rejection of Claim 32 Should be Separately Reversed, as Neither Wolff '841 nor Nachtsheim Teaches or Suggests That a Reference to Print Content Stored at an Internet Location is Sent by a Portable Device to a Print Device, as Defined in Claim 32.**

Claim 32 defines, among other things, "obtaining a reference to print content stored at an Internet location indicated by the reference" and "wirelessly communicating the communication signal to a print device". This means that the reference to print content stored at an Internet location is indicated by the reference that is sent by the portable device. Further, the portable device in claim 32 wirelessly communicates the communication signal including the reference to a print device. In Wolff '841, by contrast, as shown in FIG. 9, the PDA 930 wirelessly communicates with the network 900. C8, L48-53. This is a significant difference, as this allows the invention of claim 32 to be used with stand-alone printers outside a network for print by reference operations.

As for Nachtsheim, the reference identifies Bluetooth-capable devices that are powered on an airplane and allows the staff of an airplane to tell the users to turn the devices off. C2, L39-57. This is entirely unrelated to communication with a print device or a print service.

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D. The Rejection of Claim 33 Should be Separately Reversed, as Neither Wolff '841 nor Nachtsheim Teaches or Suggests that a Reference to Print Content Stored at an Internet Location is Sent by a Portable Device to a Print Service, as Defined in Claim 33.

Claim 33 defines, among other things, "obtaining a reference to print content stored at an Internet location indicated by the reference" and "wirelessly communicating the communication signal to a print service". This means that the reference to print content stored at an Internet location is indicated by the reference that is sent by the portable device. Further, the portable device in claim 33 wirelessly communicates the communication signal including the reference to a print service. Again, in Wolff '841, the PDA 930 wirelessly communicates with the network 900. FIG. 9; C8, L48-53. This difference is also significant, as it allows the invention of claim 33 to be used with stand-alone print services outside a network for print by reference operations. Nachtsheim, as explained above with respect to claim 32, adds nothing to the teaching of Wolff '841 in this regard.

CONCLUSION

For the above reasons, Applicant requests the Board to reverse the outstanding rejections. The case should be permitted to pass to allowance.

Respectfully submitted,

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CLAIMS APPENDIX

1.   (Cancelled)

2.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the reference specifies billing information.

3.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the reference specifies print format information.

4.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the

reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the reference specifies time and date information.

5.   (Cancelled)

6.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the reference specifies a number of copies of the print content to be printed by a print device.

7-14. (Cancelled)

15.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference;

wirelessly communicating the reference to another device to initiate a print by reference of the print content; and

communicating a discovery signal that comprises a request for information about a capability of the another device.

16.   (Cancelled)

17.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference;

wirelessly communicating the reference to another device to initiate a print by reference of the print content; and

receiving a print status message from the another device.

18.   The method of claim 17 further comprising the step of displaying the print status message received from the another device.

19-20. (Cancelled)

21.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the another device comprises a print service adapted to use the reference to obtain the print content.

22.   The method of claim 21 wherein the reference specifies a print device to which the print service is adapted to transmit the print content.

23.   The method of claim 21 further comprising the step of receiving the print content from the print service.

24.   The method of claim 23 further comprising the step of passing the print content to a print device for printing.

25-29. (Cancelled)

30.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and,

wirelessly communicating the reference to another device to initiate a print by reference of the print content;

wherein the reference further specifies a print format data specifying that the print content should be printed beginning on a new sheet of paper.

31.   (Cancelled)

32.   A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print device thereby causing the print device to use the reference to retrieve the print content from the Internet and to print the print content.

33. A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print service thereby causing the print service to use the reference to retrieve the print content from the Internet, to format the print content for printing, and to pass the print content to a print device for printing.

EVIDENCE APPENDIX

(None)

RELATED PROCEEDINGS APPENDIX

(None)

CERTIFICATE OF SERVICE

None. (This is not a reexamination proceeding, and none is required.)